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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,376	04/20/2004	Nozomu Tamoto	252035US DIV	3769
22850	7590	02/24/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			RONESI, VICKEY M	
			ART UNIT	PAPER NUMBER

1714

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/827,376

Applicant(s)

TAMOTO ET AL.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-32 and 47-50 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,7-25,28-32 and 47-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1,2,7-32 and 47-50 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/27/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Upon reconsideration, the election of species requirement that was set forth in Office Action dated 10/14/2004 has since been withdrawn by the examiner.
2. Claims 1, 2, 7-25, 28-32, and 47-50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 1/27/2005.
3. Applicant's election with traverse of claims 26 and 27 in the reply filed on 1/27/2005 is acknowledged. The traversal is on the grounds that (A) with respect to Groups II and I, the Office has not provided evidence to support that the intermediate products are useful as the Office has suggested; (B) with respect to Groups III and I, the Office has failed to show that the alleged process of "dip coating" is materially different from the claimed process; (C) with respect to Groups II and III, the Office has not provided evidence to support that the claimed product is useful as the Office has alleged; (D) with respect to Groups II and III, the Office has failed to show that its alleged use of the claimed product is materially different from what is claimed; (E) with respect to Groups I and IV, the Office has not provided evidence to support that the claimed product is useful as the Office has alleged; (F) with respect to Groups I and IV, the Office has failed to show that its alleged use of the claimed product is materially different from what is claimed; (G) with respect to Groups II and IV, the Office has not provided sufficient reasons and/or examples to support this assertion; and (H) with respect to Groups III

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and IV, the Office has not provided reasons and/or examples to support that invention III has separate utility.

4. These arguments are not found persuasive because of the following reasons:

With respect to arguments A through H, the examiner has already shown on pages 2 and 4 in Office Action mailed 10/14/2004 that, *prima facie*, there is a serious search burden on the examiner. Applicants' attention is drawn to MPEP 803.01 which states that the "*prima facie* showing may be rebutted by appropriate showings or evidence by the applicant." No such showing has yet been made by applicants, only conclusory statements have been made.

With respect to arguments A, C, and E, applicants' attention is drawn to MPEP 803.01 which states that "Examiners must provide reasons and/or examples to support conclusions, but need not cite documents [i.e., evidence] to support the restriction requirement" (emphasis added).

With respect to arguments B and D, it is the examiner's position that it is known to one of ordinary skill in the art that spray coating (presently claimed method) and dip coating are materially different since they require different applicator equipment.

With respect to arguments F and H, it is the examiner's position that it is known to one of ordinary skill in the art that method involving charging the photoreceptor (presently claimed method) and methods utilizing an ionographic pen are materially different processes since they involve different charging means. The examiner is not required to provide examples to support said reasoning.

With respect to argument G, it is the examiner's position that sufficient reasoning has been set forth in Office Action mailed 10/14/2004. In particular, the coating solution in Group II

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is unrelated to Group IV since there appears to be no relationship between the two. Group IV fails to recite or refer to the use of the liquid coating solution in Group II.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Objections***

5. Claim 26 is objected to because the term “plural organic solvents” in line 2 of the claim has antecedent basis in claim 26 and should therefore read as “the plural organic solvents.”

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsushita (Derwent Abstracts, 1991-356747 of JP 03-237617).

A full English-language translation of JP 03-237617 A has been ordered.

It is noted that the intended use recited in claim 26, “for an outermost layer of an electrophotographic photoreceptor,” has been given no patentable weight. Case law holds that “where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation.” See *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

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Matsumura discloses a paint composition comprising alumina, an organic phosphate compound preferably having an acid value ranging from 7-100; polyurethane resin; and organic solvent which is prepared by mixing in a ball mill containing alumina balls.

In light of the above, it is clear that the Derwent abstract anticipates the presently cited claims.

7. Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Gosselink et al (US 3,736,134, cited on IDS dated 8/27/2004) in view of evidence given by Yamamori et al (US 2002/0011177, cited on IDS dated 8/27/2004).

Gosselink et al discloses a photoconductive imaging layer comprising a binder resin, an inorganic oxide (col. 3, lines 51-59; col. 4, lines 9-13); a carboxylic acid (col. 3, line 66 to col. 4, line 8); a binder resin (col. 4, lines 14-31); and multiple solvents, i.e., toluene and methanol (col. 7, lines 1-15). Absent evidence to the contrary, it is the examiner's position that the carboxylic acids listed in Gosselink et al have acid values that overlap with the presently claimed range since there is no evidence that the carboxyl groups are neutralized and the presently claimed range is especially broad. For example, Gosselink et al exemplifies the use of a carboxylic acid such as abietic acid which has an acid value of 160 as evidence by Yamamori et al (paragraph 0093).

In light of the above, it is clear that Gosselink et al anticipates the presently cited claim.

8. Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Carolla (US 4,820,620, cited on IDS dated 8/27/2004).

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Carolla discloses a photoconductive film comprising a filler such as zinc oxide and titanium dioxide (col. 7, lines 35-45); an organic acid (col. 4, lines 5-28; col. 8, lines 41-47); a resinous binder (abstract); and multiple solvents, i.e., toluene and methanol (col. 7, lines 35-45; col. 9, lines 57-67). Absent evidence to the contrary, it is the examiner's position that the organic acids listed in Carolla have acid values that overlap with the presently claimed range since there is no evidence that the carboxyl groups are neutralized and the presently claimed range is especially broad.

In light of the above, it is clear that Carolla anticipates the presently cited claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Gosselink et al (US 3,736,134) or Carolla (US 4,820,620) in view of Misawa et al (US 4,405,419).

The discussions with respect to Gosselink et al and Carolla et al in paragraphs 7 and 8, respectively, are incorporated here by reference.

Gosselink et al discloses that its composition is prepared by ball milling (col. 4, line 63).

Carolla discloses that its composition is blended with a ball mill (col. 7, line 12).

Neither Gosselink et al nor Carolla teach the use of a ball mill containing alumina balls.

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Misawa et al teaches that ball mills containing alumina balls are preferable to use under wet conditions since it is resistant to acidic conditions (col. 4, lines 9-20).

Given that both Gosselink et al and Carolla are open to the use of a ball mill and given the teachings by Misawa et al regarding the benefits of using an alumina ball mill involving wet and acidic conditions, it would have been obvious to one of ordinary skill in the art to utilize an alumina ball mill in mixing the compositions of Gosselink et al and Carolla and thereby arrive at the presently cited claim.

### *Correspondence*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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A handwritten signature, possibly reading 'VR', in black ink.

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